

REMARKS

Claims 33-56 are pending in the application. Claims 36 and 39 were rejected under 35 U.S.C. § 112, first paragraph. Claims 33-53 were rejected for nonstatutory obviousness type double patenting. Each of the rejections is addressed as follows.

Rejection under 35 U.S.C. § 112, first paragraph

Dependent claims 36 and 39 were rejected under 35 U.S.C. § 112, first paragraph, “as based on a disclosure which is not enabling.” For the following reasons, applicants respectfully traverse this rejection.

The Office relies on *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (C.C.P.A. 1976), in essence, for the proposition that claims failing to recite a critical or essential element of the practice of the invention fail for lack of an enabling disclosure. There, in *Mayhew*, however, the method claims omitted a step without which the invention as claimed was wholly inoperative, meaning it simply would not work and could not produce the claimed product. Such is not the case in this situation. Here, *arguendo*, the lack of a limitation directed to the average size of a biologically active compound solid particles or agglomerates is not a failure to describe a necessary element of the claimed method. This is because, as is described in applicants’ specification, particles of a bioactive compound suspended in a fluid can be significantly reduced in size by flowing the bioactive compound through one or more magnetic fields. The only required description, then, is of the flowing of a suspended compound through one or more

magnetic fields to reduce the average size of a portion of the compound as claimed. Applicants' specification and accompanying definitions and examples satisfy this requirement. Thus, the lack of a limitation directed to the average size of biologically active compound solid particles or agglomerates does not render the invention inoperable and therefore does not run afoul of *Mayhew*, 527 F.2d at 1233, 188 USPQ at 358 (affirming examiner's rejection of claims not limited to having a cooling zone at the exit of a steel strip from a zinc bath because the specification indicated that without that cooling bath the invented process would not work).

Furthermore, applicants point out that the recitation of a specific size would be unduly restrictive. Reading the claims, as they must be read, in the light of the specification, applicants believe that the size of biologically active compound solid agglomerates or biologically active compound solid particles is clear from the other recitations of the claims and that selection of such agglomerates or particles for use in the claimed method would be within the ability of one of ordinary skill in the art attempting to follow the teaching of the specification.

Obviousness-Type Double Patenting

Claims 33-53 were rejected on the ground of obviousness-type double patenting over various claims of U.S. Patent 7,384,560. Applicants respectfully request this rejection be held in abeyance until patentable subject matter is identified. At such time, a terminal disclaimer will be filed, if appropriate.

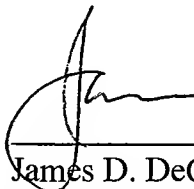
CONCLUSION

Applicants submit that the claims are in condition for allowance and such action is respectfully requested.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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